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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,963	06/11/2002	James B. Kargman	991131	8981
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GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			EXAMINER ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,963

Applicant(s)

KARGMAN, JAMES B.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11 have been examined.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Specifically, "ZIPM.COM" is found on page 15, lines 8 and 12, and on page 21, line 3; "newspaper.com" is found on page 30, line 12.

The disclosure is objected to because of the following informalities: On page 4, lines 6-7, "crisis-cross" is presumably an error for "criss-cross", unless Applicant has chosen to indulge in deliberate wordplay. On page 13, line 21 (the second last line on the page), "an graphic component" should be "a graphic component". On page 19, line 15, "Fig. 5.." should be "Fig. 5." with one period. On page 28, line 2, "Table 40" should be "Table 640" to correspond with Figure 7.

Appropriate correction is required.

Claim Objections

Claims 1-11 are objected to because of the following informalities: In the eleventh line of claim 1, "the list of recipients" technically lacks antecedent basis, and should be "a list of recipients". Appropriate correction is required.

Claim 3 is objected to because of the following informalities: In claim 3, "the user" technically lacks antecedent basis. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: In claim 4, "the completed template" technically lacks antecedent basis. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: "According to claim1" should be "according to claim 1". Also, "the user" in "the user's profile" technically lacks antecedent basis. Appropriate correction is required.

Claims 8-11 are objected to because of the following informalities: In claim 8, "the user" technically lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott ("You've Got Snail Mail!") in view of Sparks et al. (U.S. Patent 6,167,382) and Rosser (U.S. Patent 6,446,261). As per claim 1, Scott discloses a method for creating a direct mail advertisement and designating recipients thereof via the Internet, including the step of electronically transmitting data files comprising the design of a direct mail advertisement and the list of recipients toward printing individual copies of the direct

mail advertisement to the intended recipients thereof; and logging on to a web site via the Internet (paragraph beginning "Pitney Bowes is developing a program called Mail Essentials"). Scott does not disclose selecting from one or more pre-defined designs a design for the front side of a direct mail advertisement; selecting a design for the back side of a direct mail advertisement; and specifying the text that appears on the back side of a direct mail advertisement. Sparks, however, teaches selecting from one or more pre-defined designs a design for the front side of an advertisement, selecting a design for the back side of an advertisement, and specifying text for an advertisement (Abstract; column 1, line 66, through column 2, line 48; column 8, line 53, through column 9, line 3; column 10, lines 17-36; column 22, lines 7-56; Figures 55 and 56), and teaches that the finished advertisement may be mailed as direct mail (column 1, lines 42-50). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to perform these steps, for the stated advantages of reduced time and cost in developing advertising materials (column 2, lines 12-20 of Sparks).

Scott does not expressly disclose the steps of specifying one or more criteria that define the intended recipient class for the direct mail advertisement; and compiling the list of recipients for the direct mail advertisement corresponding to the specified criteria, but this is well known procedure, as taught, for example, by Rosser (column 2, lines 30-49). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to carry out these steps, for the stated

advantage of reaching all of the audience who are highly predisposed to purchase the advertised product, with the minimum of expense.

As per claim 2, Sparks discloses selecting from among one or more predefined templates (Abstract, etc.). Hence, this would have been obvious at the time of applicant's invention, for the reasons set forth above in applying Sparks to claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott, Sparks, and Rosser as applied to claim 1 above, and further in view of Jecha et al. (U.S. Patent 6,631,375). Neither Scott nor Sparks discloses selecting from among one or more templates uploaded by a user, but Jecha teaches uploading one or more templates from a user (column 4, lines 29-43; column 6, lines 17-30). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select from among one or more templates uploaded by a user, for the obvious advantage of having the advertisement created in exact accordance with a user's wishes.

Claims 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott, Sparks, and Rosser as applied to claim 1 above, and further in view of official notice. As per claim 4, neither Scott nor Sparks expressly discloses saving the completed template appearing on the back side of the direct mail advertisement for later recall, or as per claim 5, selecting from one or more previously saved templates (at least in the sense of selecting templates previously saved by the client; the templates in Sparks were presumably previously saved by the system proprietor), but official notice is taken that it is well known to save one's work, and select from one or more previously

saved items. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to save the completed template, as per claim 4, and to select from one or more previously saved templates, as per claim 5, for the obvious advantage of saving time by not having to re-create from scratch the same advertisement, or a quite similar advertisement (involving, e.g., the same place of business, and the same hamburger [as in Sparks], but coupons with different expiration dates).

As per claim 7, Scott does not disclose identifying the user's profile and security rights toward filtering the list of recipients for the direct mail advertisement, but official notice is taken that it is well known to identify a user and establish his security rights. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of preventing unauthorized persons from accessing confidential information, or misusing the Website disclosed by Scott to have documents printed and mailed without payment.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott, Sparks, and Rosser as applied to claim 1 above, and further in view of Arledge, Jr. et al. (U.S. Patent 6,535,294). Neither Scott nor Sparks discloses uploading user supplied artwork and logos for inclusion on the direct mail advertisement, but Arledge teaches uploading user supplied artwork and logos for inclusion in a printed product (column 15, lines 35-44; column 15, line 67, through column 16, line 12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to upload artwork and logos for inclusion on the direct mail

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advertisement, even on the back side thereof, for the obvious advantage (see Arledge, columns 3-6) of printing the user's business logos or other artwork on customized printed products.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott, Sparks, and Rosser as applied to claim 1 above, and further in view of official notice. As per claim 8, Scott does not expressly disclose that the step of logging into a web site via the Internet further includes the step of identifying the URL used by the user, but official notice is taken that it is well known for logging onto a web site to include the step of identifying the URL used by the user. Web sites often include multiple web pages with different URL's (e.g., www.joeblowspersonalsite.com/homepage.html, www.joeblowspersonalsite.com/mypictures.html, www.joeblowspersonalsite.com/Joes_friends.html, www.joeblowspersonalsite.com/myinterests.html, etc.), and the URL which a user uses to enter the site must be identified to determine which page will be displayed. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to identify the URL, for the obvious advantage of displaying the appropriate web page.

As per claims 9, 10, and 11, official notice is taken, respectively, that it is well known for different web pages to have different visual appearances, different content, and user selectable different options. Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention for all of these to have depended on the URL used to log onto the web site.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Colvin, Sr. (U.S. Patent 5,825,881) discloses a public network merchandising system (which includes uploading graphics, etc.). Farros et al. (U.S. Patent 5,930,810) disclose a printing system with pre-defined user modifiable forms and local and remote printing. Warmus et al. (U.S. Patent 5,963,968) disclose an apparatus and method for controlling an electronic press to print fixed and variable information. Donohue et al. (U.S. Patent 5,987,480) disclose a method and system for delivering documents customized for a particular user over the Internet using imbedded dynamic content.

Desautels et al. (EP 0 814425 A2) disclose a method for creating complex layouts with variable data for high speed printing systems.

Andelman ("Mail-by-Wire") discloses electronically transmitting direct mail messages to be printed out and mailed. Read ("Spokane Printers Are Embracing Digital Wave") discloses digital printing; note especially paragraph beginning, "He says United Lithographers". The anonymous article, "MySoftware Company™ and Pitney Bowes Announce New Direct Marketing Product," discloses enabling small businessmen to complete a direct mail campaign entirely from their desktops. Kleinman ("Net Service for Mailings") also describes the Pitney Bowes Internet-based direct mail

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service. (Published after the filing of Applicant's provisional application, the Kleinman article is not relied on as prior art, but is made of record as of possible interest, e.g., for finding possible earlier articles or evidence of the system it describes.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

September 21, 2005